

Application Serial No.: 09/783,666
Amendment dated: May 20, 2004

Reply to Office action of: April 8, 2004
Attorney Docket No.: ARC920010009US1

REMARKS

This Amendment is in response to the Office Action of April 8, 2004. Applicants respectfully submit that all the claims presently on file are in condition for allowance, which action is earnestly solicited.

THE CLAIMS

CLAIMS REJECTION UNDER 35 U.S.C. 102

Claims 1,2, and 4-10 were rejected under 35 U.S.C. 102(b) as being anticipated by DeLorme et al. (5,948,040) (hereinafter "DeLorme"), reasoning that:

"4. As per claim 1, DeLorme discloses a method for automatic relevance-based preloading data to a computing device (col 48, lines 5-33), comprising: identifying any one or more of persons or current scheduled tasks prior to the occurrence of the tasks (fig 5, col 48, lines 47_67); analyzing the relevance of stored data (col 49, lines 1-6) to any one or more of the current scheduled tasks or persons (col 49, lines 1-32); sorting the stored data based (col 49, lines 51-59) upon the relevance to any one or more of the current scheduled tasks or persons (col 49, lines 33-59); setting a predetermined relevance threshold (col 48, lines 5-33, zip code, phone exchange areas are setting relevance threshold), and preloading (col 48, 30-33, transferring is preloading) selected sorted data to the computing device (col 48, lines 25-33) with relevance higher than the relevance threshold (col 48, lines 5-33).

5. As per claim 2, DeLorme discloses analyzing the relevance includes estimating a proximity of the stored data items to any one or more of persons or current scheduled tasks, based on one or more of three proximity measures distance, time, association (col 22, lines 19-37)."

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Applicants respectfully traverse these rejection grounds and submit that DeLorme does not disclose all the elements and limitations of claims 1,2, and 4-10. Consequently, claims 1,2, and 4-10 are not anticipated under 35 U.S.C. 102, and the allowance of these claims and the claims dependent thereon are earnestly solicited. In support of this position, Applicants submit the following arguments:

A. Legal Standard for Lack of Novelty (Anticipation)

The standard for lack of novelty, that is, for "anticipation," is one of strict identity. To anticipate a claim for a patent, a single prior source must contain all its essential elements, and the burden of proving such anticipation is on the party making such assertion of anticipation. Anticipation cannot be shown by combining more than one reference to show the elements of the claimed invention. The amount of newness and usefulness need only be minuscule to avoid a finding of lack of novelty.

The following are two court opinions in support of Applicants' position of non anticipation, with emphasis added for clarity purposes:

- "Anticipation under Section 102 can be found only if a reference shows exactly what is claimed; where there are differences between the reference disclosures and the claim, a rejection must be based on obviousness under Section 103." *Titanium Metals Corp. v. Banner*, 778 F.2d 775, 227 USPQ 773 (Fed. Cir. 1985).
- "Absence from a cited reference of any element of a claim of a patent negates anticipation of that claim by the reference." *Kloster Speedsteel AB v. Crucible Inc.*, 793 F.2d 1565, 230 USPQ 81 (Fed. Cir. 1986), on rehearing, 231 USPQ 160 (Fed. Cir. 1986).

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Since claim 1 has been amended to include come of the limitations of claim 2, the arguments will address the examiner's rejection to claims 1 and 2.

The office action states that: "15. As per claim 3, ... DeLorme fails to disclose relevance score." Claim 1 is now amended to clarify that the "relevance score" should be higher than the relevance threshold. As a result, claim 1 as amended contains a feature or element that is admittedly not recited by DeLorme. Consequently, the foregoing legal authorities necessitate the finding of non-anticipation and allowance of claim 1 and the claims dependent thereon.

In addition, the present claim 1 recites a "method for automatic relevance-based preloading data" that automatically preloads selected sorted data to the computer device. In other terms, the present invention calculates the relevance score of the data based on an association proximity measure and at least one proximity measure (claim 1), or at least three specific criteria; compares the calculated relevance score to a relevance threshold (claim 2); and automatically preloads the data with a relatively high relevance score.

More specifically, DeLorme describes a user-initiated loading process, whereby the user "defines" the criteria (i.e., the beginning and destination) and based on these criteria the system determines the trip information that is loaded to a portable computer. On the other hand, the present invention

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describes an automatic loading process of stored data based on the calculated relevance score proximity to the threshold.

Applicants further submit that DeLorme does not set "a predetermined relevance threshold." The office action states that DeLorme sets "a predetermined relevance threshold (col 48, lines 5-33, zip code, phone exchange areas are setting relevance threshold)."

Applicants submit that the values described by DeLorme do not qualify as relevance threshold in that:

(1) The calculated relevance score of the stored data is compared to the relevance threshold. DeLorme, on the other hand, does not compare the zip code of the phone number to the calculated relevance score.

(2) According to the present invention, if the calculated relevance score is "higher" than the threshold, the data is automatically loaded. However, in DeLorme, if either the zip code (e.g., 410) is "greater" than a threshold zip code (e.g., 409), then the stored data is not automatically loaded.

Applicants submit that what the examiner refers to as relevance threshold in DeLorme could be viewed as a "filter" but not a relevance threshold as intended to be used and as actually recited in the instant claim 1.

Furthermore, DeLorme does not disclose: analyzing the relevance score by "estimating a proximity of the stored data items to any one or more of

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persons or current scheduled tasks, based on at least three proximity measures: distance, time, and association." DeLorme does consider the combination of the three proximity measures: distance, time, and association.

To conclude, claims 1 and 2, as amended and the claims dependent thereon (more specifically, claims 3 and 4 - 10) are not anticipated by DeLorme, and the allowance of these claims is respectfully requested.

CLAIMS REJECTION UNDER 35 U.S.C. 103

Claims 3 and 11 - 20 were rejected under 35 U.S.C. 103(a) as being unpatentable over DeLorme et al. (5,948,040) ("DeLorme") in view of Liddy et al. (6,026,383) ("Liddy"), hereinafter collectively referred to as the cited references, reasoning that:

"15. As per claim 3, DeLorme discloses step of analyzing the relevance further includes combining three proximity measures into a single relevance (col 22, lines 19-37). DeLorme fails to disclose relevance score. However, Liddy discloses relevance score (col 4, lines 1-2). Therefore, it would have been obvious to one of ordinary skill in the art at the time invention was made to combine Liddy with DeLorme because it would provide optimal trip planner and the proximity decision will be based on the relevance score."

Applicants respectfully traverse this rejection and submit that the claims as amended, are not obvious in view of the cited references, and are thus patentable thereover. In support of this position, Applicants submit the following arguments.

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A. Legal Standard for Obviousness

The following legal authorities set the general legal standards in support of Applicant's position of non obviousness, with emphasis added for added clarity:

- MPEP 706.02(j), **"To establish a prima facie case of obviousness, three basic criteria must be met.** First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, **the prior art reference (or references when combined) must teach or suggest all the claim limitations.** The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art and not based on applicant's disclosure. In re Vaeck, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991) ... The initial burden is on the examiner to provide some **suggestion of the desirability** of doing what the inventor has done. "To support the conclusion that the claimed invention is directed to obvious subject matter, either the **references must expressly or impliedly suggest the claimed invention** or the examiner must present a convincing line of reasoning as to why the artisan would have found the claimed invention to have been obvious in light of the teachings of the references." Ex parte Clapp, 227 USPQ 972, 973 (Bd. Pat. App. & Inter. 1985)."
- **In determining the differences between the prior art and the claims, the question under 35 U.S.C. 103 is** not whether the differences themselves would have been obvious, but **whether the claimed invention as a whole would have been obvious.** The prior art perceived a need for mechanisms to dampen resonance, whereas the inventor eliminated the need for dampening via the one-piece gapless support structure. "Because that insight was contrary to the understandings and expectations of the art, the structure effectuating it would not have been obvious to those skilled in the art." 713 F.2d at 785, 218 USPQ at 700 (citations omitted).

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- MPEP §2143.03, "All Claim Limitations Must Be Taught or Suggested: To establish prima facie obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. In re Royka, 490 F.2d 981, 180 USPQ 580 (CCPA 1974). "All words in a claim must be considered in judging the patentability of that claim against the prior art." In re Wilson, 424 F.2d 1382, 1385, 165 USPQ 494, 496 (CCPA 1970). If an independent claim is nonobvious under 35 U.S.C. 103, then any claim depending therefrom is nonobvious. In re Fine, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988)."
- MPEP §2143.01, "The Prior Art Must Suggest The Desirability Of The Claimed Invention: There are three possible sources for a motivation to combine references: the nature of the problem to be solved, the teachings of the prior art, and the knowledge of persons of ordinary skill in the art." In re Rouffet, 149 F.3d 1350, 1357, 47 USPQ2d 1453, 1457-58 (Fed. Cir. 1998) (The combination of the references taught every element of the claimed invention, however without a motivation to combine, a rejection based on a prima facie case of obvious was held improper.). The level of skill in the art cannot be relied upon to provide the suggestion to combine references. Al-Site Corp. v. VSI Int'l Inc., 174 F.3d 1308, 50 USPQ2d 1161 (Fed. Cir. 1999).
- "Obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching or suggestion supporting the combination." In re Fine, 837 F.2d at 1075, 5 USPQ2d at 1598 (citing ACS Hosp. Sys. v. Montefiore Hosp., 732 F.2d 1572, 1577, 221 USPQ 929, 933 (Fed. Cir. 1984)). What a reference teaches and whether it teaches toward or away from the claimed invention are questions of fact. See Raytheon Co. v. Roper Corp., 724 F.2d 951, 960-61, 220 USPQ 592, 599-600 (Fed. Cir. 1983), cert. denied, 469 U.S. 835, 83 L. Ed. 2d 69, 105 S. Ct. 127 (1984). "
- "When a rejection depends on a combination of prior art references, there must be some teaching, suggestion, or motivation to combine the references. See In re Geiger, 815 F.2d 686, 688, 2 USPQ2d 1276, 1278 (Fed. Cir. 1987). "Obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either explicitly or implicitly in the references themselves or in the

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knowledge generally available to one of ordinary skill in the art. See MPEP 2143.01; *In re Kotzab*, 217 F.3d 1365, 1370, 55 USPQ2d 1313, 1317 (Fed. Cir. 2000); *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988); and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992).

- "With respect to core factual findings in a determination of patentability, however, the **Board cannot simply reach conclusions based on its own understanding or experience** -- or on its assessment of what would be basic knowledge or common sense. **Rather, the Board must point to some concrete evidence in the record** in support of these findings." See *In re Zurko*, 258 F.3d 1379 (Fed. Cir. 2001).
- "We have noted that **evidence of a suggestion, teaching, or motivation to combine** may flow from the prior art references themselves, the knowledge of one of ordinary skill in the art, or, in some cases, from the nature of the problem to be solved, see *Pro-Mold & Tool Co. v. Great Lakes Plastics, Inc.*, 75 F.3d 1568, 1573, 37 USPQ2d 1626, 1630 (Fed. Cir. 1996), *Para-Ordinance Mfg. v. SGS Imports Intern., Inc.*, 73 F.3d 1085, 1088, 37 USPQ2d 1237, 1240 (Fed. Cir. 1995), although "the suggestion more often comes from the teachings of the pertinent references," *Rouffot*, 149 F.3d at 1355, 47 USPQ2d at 1456. The range of sources available, however, does not diminish the requirement for actual evidence. That is, **the showing must be clear and particular**. See, e.g., *C.R. Bard*, 157 F.3d at 1352, 48 USPQ2d at 1232. **Broad conclusory statements regarding the teaching of multiple references, standing alone, are not "evidence."** E.g., *McElmurry v. Arkansas Power & Light Co.*, 995 F.2d 1576, 1578, 27 USPQ2d 1129, 1131 (Fed. Cir. 1993) ("More denials and conclusory statements, however, are not sufficient to establish a genuine issue of material fact."); *In re Sichert*, 566 F.2d 1154, 1164, 196 USPQ 209, 217 (CCPA 1977)." See *In re Dembiczak*, 175 F.3d 994 (Fed. Cir. 1999).
- "To prevent the use of hindsight based on the invention to defeat patentability of the invention, **this court requires the examiner to show a motivation to combine the references** that create the case of obviousness. In other words, **the examiner must show reasons** that the skilled artisan, confronted with the same problems as the inventor and with no knowledge of the claimed invention, would select the elements from the cited prior art references **for combination in the manner claimed**." See *In re Rouffot*, 149 F.3d 1350 (Fed. Cir. 1998).

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- The mere fact that references can be combined or modified does not render the resultant combination obvious **unless the prior art also suggests the desirability of the combination**. In re Mills, 916 F.2d 680, 16 USPQ2d 1430 (Fed. Cir. 1990). Although a prior art device "may be capable of being modified to run the way the apparatus is claimed, **there must be a suggestion or motivation in the reference** to do so." 916 F.2d at 682, 16 USPQ2d at 1432.). See also In re Fritch, 972 F.2d 1260, 23 USPQ2d 1780 (Fed. Cir. 1992) (flexible landscape edging device which is conformable to a ground surface of varying slope not suggested by combination of prior art references).
- If the **proposed modification would render the prior art invention being modified unsatisfactory** for its intended purpose, **then there is no suggestion or motivation** to make the proposed modification. In re Gordon, 733 F.2d 900, 221 USPQ 1125 (Fed. Cir. 1984).

B. Application of the Obviousness Standard to the Present Invention

Applicants respectfully incorporates by reference the arguments made earlier in favor of the non-anticipation of claim 1 by DeLorme, and further submit that although Liddy uses the term relevance score (col 4, lines 1-2), Applicants do not claim the concept of relevant score in the abstract, but rather in the specific context of a **method for the automatic relevance-based preloading data to a computing device**. The relevance score in Liddy is used in the context of determining the position of a document position within a folder and not in the context of automatic relevance-based data preloading to a computing device.

Applicant further respectfully submit that since the main reference, namely DeLorme, does not recite essential elements of the present invention

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as recited in claim 1, the design resulting from the hypothetical combination of the cited references, would not render the invention legally obvious.

As stated earlier, "[w]hen a rejection depends on a combination of prior art references, there must be some teaching, suggestion, or motivation to combine the references." Applicants respectfully submit that the motivations or suggestions provided in the office action do not provide sufficient suggestion of the desirability of doing what the inventor has done in that the cited references do not expressly or impliedly suggest the claimed invention.

In support of this statement, Applicants submit that the motivation to combine the cited references, as provided by the office action, is as follows: "Therefore, it would have been obvious to one of ordinary skill in the art at the time invention was made to combine Liddy with DeLorme because it would provide optimal trip planner and the proximity decision will be based on the relevance score." Emphasis added. The foregoing justification describes a "general interest," and does not meet the burden of proving obviousness, since this justification does not consider the invention as a whole.

D. Independent Claims 11, 19, and 21

Applicants incorporate by reference the presentation made earlier in support of the allowance of claim 1, and submit that the independent claims 11, 19, and 21 are similarly not obvious in view of the cited references,

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for containing generally comparable elements and limitations. As a result, the independent claims 11, 19, and 21 and the claims dependent thereon are allowable over the cited references of record, whether taken individually or in combination with each other.

CONCLUSION

All the claims presently on file in the present application are in condition for immediate allowance, and such action is respectfully requested. If it is felt for any reason that direct communication would serve to advance prosecution of this case to finality, the Examiner is invited to call the undersigned at the below-listed telephone number.

Respectfully submitted,

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Samuel A. Kassatly Law Office
20690 View Oaks Way
San Jose, CA 95120
Tel: (408) 323-5111
Fax: (408) 323-5112



Samuel A. Kassatly
Attorney for Applicants
Reg. No. 32,247